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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,005	03/23/2001	Alastair J. Angwin	RSW920000160US1	5189

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12/29/2005

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EXAMINER

MANIWANG, JOSEPH R

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,005

Applicant(s)

ANGWIN ET AL.

Examiner

Joseph R. Maniwang

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-11,13-19 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11,13-19 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the Appeal Brief filed on 10/17/05, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

2. To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

3. A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

David Wiley

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2144

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 5-11, 14-19, 22, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Apfel et al. (U.S. Pat. No. 6,510,453), hereinafter referred to as Apfel.

6. Regarding claims 1, 10, and 19, Apfel disclosed a method and system for providing personal data to a recipient comprising providing a personal data object, wherein the personal data object includes personal data and a template with embedded code for generating a personal data output (see column 2, lines 1-30; column 14, lines 28-36); receiving a credential for the recipient (see column 14, lines 44-52); activating the embedded code in the template to dynamically generate a personal data output based on the at least one credential (see column 2, lines 17-21; column 3, lines 43-55; column 14, lines 44-52); and delivering the personal data output to the recipient (see column 15, lines 13-26).

7. Regarding claims 2, 11, and 22, Apfel disclosed the credential comprising an e-mail address (see column 2, lines 18-21; column 14, lines 44-52).

8. Regarding claims 5, 14, and 23, Apfel disclosed the personal data output comprising an electronic business card (see column 1, lines 25-41).

9. Regarding claims 6 and 15, Apfel disclosed delivering the personal data output to the recipient comprising attaching the personal data output to an e-mail message (see column 2, lines 1-20).

Art Unit: 2144

10. Regarding claims 7 and 16, Apfel disclosed the method performed by a client device (see column 6, lines 4-60).

11. Regarding claims 8 and 17, Apfel disclosed the client device as a computer, PDA, telephone device, or pager (see column 6, lines 4-60).

12. Regarding claims 9 and 18, Apfel disclosed the method performed by a server (see column 6, lines 4-60).

13. Claims 1, 2, 4-11, 13-19, and 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Douvikas et al. (U.S. Pat. No. 6,633,311), hereinafter referred to as Douvikas.

14. Regarding claims 1, 10, and 19, Douvikas disclosed a method and system for providing personal data to a recipient comprising providing a personal data object (see column 8, lines 7-17), wherein the personal data object includes personal data (see column 8, lines 52-53) and a template with embedded code for generating a personal data output (see column 13, lines 15-22); receiving a credential for the recipient (see column 9, lines 21-56); activating the embedded code in the template to dynamically generate a personal data output based on the at least one credential (see column 10, lines 58-64; column 13, lines 15-17); and delivering the personal data output to the recipient (see column 8, lines 14-17; column 10, lines 48-51).

15. Regarding claims 2, 11, and 22, Douvikas disclosed the credential ("ecardfile Members") comprising an e-mail address (see column 9, lines 40-43).

16. Regarding claims 4, 13, and 21, Douvikas disclosed the personal data object comprising a Java class and Java server page (see column 12, lines 5-6, 15-27; column 13, lines 1-6).

17. Regarding claims 5, 14, and 23, Douvikas disclosed the personal data output comprising an electronic business card (see column 2, lines 18-22; column 3, lines 56-61).

18. Regarding claims 6 and 15, Douvikas disclosed delivering the personal data output to the recipient comprising attaching the personal data output to an e-mail message (see column 10, lines 46-57).

19. Regarding claims 7 and 16, Douvikas disclosed the method performed by a client device (see column 5, lines 11-23).

20. Regarding claims 8 and 17, Douvikas disclosed the client device as a computer, PDA, telephone device, or pager (see column 13, line 64 through column 14, line 3).

21. Regarding claims 9 and 18, Douvikas disclosed the method performed by a server (see column 4, lines 1-22).

Response to Arguments

22. Applicant's arguments filed 10/17/05 have been fully considered but they are not persuasive. Additionally, Examiner submits that claims 1, 2, 5-11, 14-19, 22, and 23 are taught by the prior art as detailed in the above rejection under 35 U.S.C 102(e).

Art Unit: 2144

23. Regarding claims 1, 2, 4-11, 13-19, and 21-23 rejected under 35 U.S.C. 102(e) as being anticipated by Douvikas et al. (U.S. Pat. No. 6,633,311), Applicant traverses the rejection as follows.

24. Applicant first asserts that Douvikas does not teach or suggest a personal data object that includes a template with embedded code that may be activated to generate personal data. Examiner submits that this broadly claimed limitation is undoubtedly taught by Douvikas, where it was disclosed that an electronic business card containing personal contact information was provided to an e-mail recipient (see column 8, lines 7-17, 52-53); the card displayed using a template with embedded tags replaced by customized data (see column 13, lines 15-22).

25. Applicant next asserts that the system of Douvikas includes a database and software, both of which are separate from each other and the software being responsible for managing access and data privacy. Applicant thus states that "the software" of Douvikas is in no way embedded in a personal data object. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., software embedded in a personal data object) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The relevancy of the argument presented by Applicant is unclear as the claims do not require the noted software of Douvikas to be embedded in a personal data object, and furthermore the apparent comparison between such a software

Art Unit: 2144

component of Douvikas to the claim limitations is not understood. The claims as presented recite no software element as argued.

26. Applicant further asserts that there is no teaching in Douvikas that a personal data object includes a template with embedded code for generating personal data output, particularly where the embedded code is activated to dynamically generate a personal data output based on at least one credential. Examiner disagrees. In support, Applicant specifically states that Douvikas teaches that the known "vCard" feature contained no embedded code, citing column 8, lines 18-21. Examiner submits that this passage does not provide evidence supporting such an assertion. In fact, Examiner asserts that the portion cited teaches that a vCard (personal data object) can include embedded code (hyperlink) for generating personal data output (electronic business card access) as broadly set forth by the claim limitations.

27. Applicant further asserts that Douvikas does not teach a personal data object including personal data and a template with embedded code for generating a personal data output that is implemented in Java using a Java server page. However, Applicant acknowledges that Java classes are used to query and return results from the database. Examiner submits that the returned results from the database, such as personal data objects (see column 14, lines 9-13), were thus displayed using Java classes, and therefore generated personal data output implemented in Java as broadly set forth in the claims.

28. Finally, Applicant asserts that Douvikas does not teach delivering the dynamically generated personal data output by attaching the personal data output to an e-mail

Art Unit: 2144

message. Examiner submits that Douvikas unquestionably teaches such a feature as the personal data could be attached to an e-mail signature file (see column 10, lines 46-57; Fig. 17).

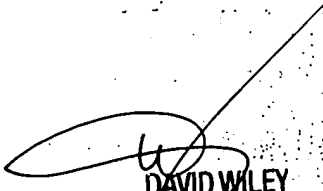
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM


DAVID WILEY
SUPERVISORY PATENT EXAMINER
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